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Signature

January 29, 2008
Date of Signature

PATENT
Case No. AUS920010440US1
(9000/43)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:)	
)	
RABINDRANATH DUTTA)	Examiner: DASS, HARISH
)	
Serial No.: 09/915,439)	
)	Group Art Unit: 3693
Filed: JULY 26, 2001)	
)	Conf. No.: 7368
Title: METHOD FOR PROVIDING)	
ANONYMOUS ON-LINE)	
TRANSACTIONS)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop **Non-Fee Amendment**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please reconsider this application as follows.

REMARKS/DISCUSSION OF ISSUES

The Examiner continues to erroneously reject these claims as obvious despite the abundant evidence that the prior art specifically and unequivocally teaches away from making the combination suggested by the Examiner.

The Examiner rejected pending claims 1-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,629,082 to *Hambrecht et al.* in view of United States Patent Publication 2001/0034631 to Kiselik in further view of United States Patent 6,691,094 to Herschkorn. §103 “forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Specifically, the references alone or in combination fail to teach or suggest “receiving agreement of the matched supplier and purchaser at the exchange server to execute the anonymous transaction” as claimed in claims 1, 11 and 21 and neither *Hambrecht* nor Kiselik teach the benefits of keeping a transaction anonymous. Instead, both *Hambrecht* and Kiselik teach that anonymity harms the transaction. In contrast, several benefits of anonymity are described in the background of the instant application, such as on pages 1 and 2 of the specification.

Indeed, Kiselik unequivocally teaches away from an anonymous transaction, by noting the benefits of requiring a “rating by the requester of the performance of the satisfier and a rating by the satisfier of the performance of the requester are entered into the computer system for continuous updating of performance ratings.” (Abstract, Kiselik). The dangers of exactly such a system are described in the instant specification on page 2, lines 1-11 – an unscrupulous purchaser or supplier can enter into a legitimate transaction to glean their business partner’s identity and then use that identity to flood an exchange with dummy orders

to manipulate market position. Therefore it is incontrovertible that Kiselik teaches away from use of an anonymous transaction as claimed – the feedback mechanism precludes true anonymity.

Hambrecht does not cure this defect of Kiselik. In fact, Hambrecht further teaches away from the instant claims. While Hambrecht does not explicitly teach that the entity being formed with the capital formation needs to know the identity of the investors, Hambrecht clearly teaches that the inventors need to know the identity of the entity being formed. For example, see the abstract:

Techniques are provided for an auction system that is used for pricing and allocating equity securities. Information about an offering to accept bids for equity shares is provided to qualified potential purchasers and non-qualified potential purchasers. Bids from potential purchasers for equity shares

Furthermore, Hambrecht implicitly requires that the issuer must know the identity of the purchaser. Without such knowledge the issuer would not be able to pay dividends, for example.

In *KSR*, the Supreme Court reiterated that claims should be held patentable where *even though the elements were known in the prior art, the fact that they work together in an unexpected manner renders the claims not obvious*. Here, the fact that the prior art teaches the desirability of a user rating system is unequivocal. Such a teaching can only teach away from the desirability of anonymous transactions. The Examiner's attempt to avoid these clear 'teachings away' by adding Herschkorn and alleging a teaching of 'anonymity' does not cure these defects. The fact that an anonymous transaction, as claimed, works in an unexpected manner renders these claims not obvious.

These claims are perhaps most similar to the *Adams* case discussed in *KSR*. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395 (emphasis added). In that matter, Adams designed a battery using certain types of electrodes, but the prior art warned that risks were involved in using the same certain types of electrodes. In *Adams*, and as affirmatively commented by the Supreme Court, the fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that the design was not obvious to those skilled in the art.

Similarly, in this matter, anonymity was known prior to these claims, but the prior art taught that anonymity was to be avoided in commercial transactions. The fact that anonymity can be beneficial is unexpected and fruitful in that the disadvantages of the prior art can be avoided. The prior art teaches away from these claims, and specifically teaches away from a method for performing an anonymous online transaction as claimed, and therefore this rejection must fall.

Simply put, the Examiner cannot conclusively assert that the subject matter of providing an anonymous online transaction, as claimed, would be obvious at the time of the invention in light of prior art that teaches that there are many benefits to a *non*-anonymous transaction. Any such assertion can only be considered impermissible hindsight.

Claims 2-10, 12-20 and 22-25 depend directly or indirectly from one of claims 1, 11, or 21, and are therefore patentable over the references for at least the same reasons.

Additional details on Appellants arguments is found in the responses filed May 9, 2006, August 22, 2007, and the appeal brief filed December 22, 2006. Withdrawal of the rejections to claims 1-25 is requested.

CONCLUSION

The Appellants respectfully submit that claims 1-25 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **January 29, 2008**

Respectfully Submitted,
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <u>AUS920010440US1</u>	
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First Named Inventor <u>RABINDRANATH DUTTA</u>		Art Unit <u>3693</u>	
Examiner <u>DASS, HARISH</u>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,983</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </div> <div style="width: 45%; text-align: right;"> <u>/FRANK C. NICHOLAS/</u> Signature <u>FRANK C. NICHOLAS/</u> Typed or printed name <u>(847) 905-7111</u> Telephone number <u>JANUARY 29, 2008</u> Date </div> </div>			
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

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